REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested. Claims 29-30 and 39-40 are canceled, new claims 41-44 are added, and claims 1-28, 31-38, and 41-44 remain pending in the application.

Claims 1-5, 8-15, 18-25, 28-35, and 38-40 stand rejected under 35 USC §103 in view of U.S. Patent Publication No. 2001/0033580 by Dorsey et al. in view of the Applicant's admitted prior art. This rejection is respectfully traversed, as the rejection is based on unfounded assertions and improper assumptions that provide no more than an improper hindsight analysis of the prior art.

In particular, the rejection is replete with unfounded assertions of obviousness mischaracterizations regarding the teachings of Dorsey et al. and the admitted prior art.

For example, the rejection mischaracterizes Dorsey by asserting on page 2 (para. 3) that "Dorsey discloses a method in a router configured for establishing an Internet Protocol (IP) connection", and continues to recite claim 1 verbatim, including "receiving a bisync protocol data frame carrying bisync protocol fields and Base-24 protocol data from an automated banking device via a serial connection".

Dorsey provides no reference or suggestion whatsoever to the claimed terms "Internet Protocol" (or even "IP"), "bisync", "Base-24", "banking" or "automated banking device", or "server" as specified in the independent claims 1, 11, 21, and 31. Hence, any assertions that Dorsey teaches these features are unfounded.

Applicant further traverses as legally improper the assertion that "the method of Dorsey is inherently capable of dealing with the situation where bisync is the first protocol and IP is the second." Inherency is not applicable in a rejection under §103. *In re Newell*, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).[1]

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[1]"That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448,150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.

Further, the rejection fails to establish that Dorsey teaches or suggests the claimed "new header specifying *attributes of the Base-24 protocol data <u>and the automated banking device</u>*", as specified in the independent claims 1, 11, 21, and 31. The rejection simply asserts that Dorsey teaches these features, without any reference to either Dorsey or Applicant's admitted prior art to support the Examiner's assertion.

Applicant's admitted prior art, while describing receiving packets from an automated banking device via a serial connection, also fails to disclose or suggest that the claimed "new header" specifies *attributes of the Base-24 protocol data <u>and the automated banking device</u>*", as specified in the independent claims. Rather, the admitted prior art simply describes the <u>encapsulation</u> of the bisync frame for transport via an alternate network connection, for example TCP/IP or Frame Relay (see, e.g., page 2, lines 12-16).

In fact, Dorsey teaches no more than a multi-protocol **packet translator** configured for translating between **link layer** (i.e., Layer 2) protocols such as Ethernet, FDDI, token ring, and Asynchronous Transfer Mode (ATM) LAN Emulation (LANE).[2]

Hence, none of the references, singly or in combination, disclose or suggest the claimed "new header" that specifies *attributes of the Base-24 protocol data <u>and the automated banking device</u>*".

The Official Action also fails to establish a prima facie case of obviousness because the rejection fails to establish one skilled in the art would have been motivated to modify Dorsey in order to include the teachings of Applicant's admitted prior art. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). "Teachings of references can be combined <u>only</u> if there is some suggestion or incentive to do so." *In re Fine*, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (*quoting ACS Hosp. Sys. v. Montefiore Hosp.*,

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[2]It also should be apparent that one skilled in the art would <u>not</u> interpret "ATM Lane 2.0" as an Automated Teller Machine.

221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

The Examiner is respectfully reminded that an obviousness rejection requires a specific showing as to why one of ordinary skill in the art would have selected the components for combination in the manner claimed.[3] "The examiner's conclusory statements ... do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" *In re Lee,* 61 USPQ2d at 1434 (*quoting W.L. Gore v. Garlock, Inc.,,* 202 USPQ 303, 312-13 (Fed. Cir. 1983)).

In particular, the assertions of obviousness are without foundation, and lacking in any rational basis. Specifically, there is no foundation for the assertion that one skilled in the art would have been motivated to modify Dorsey "in order to accept packets serially from an automated banking device because there is a need for a scalable translation between the packets sent by the automated banking device and the IP network".

In fact, the rejection fails to establish the asserted motivation of modifying Dorsey "to accept packets serially from an automated banking device." There is no evidence whatsoever of any need to modify Dorsey "to accept packets serially from an automated banking device". As

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[3]*Cf. In re Lee,* 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (*quoting In re Kotzab,* 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet,* 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch,* 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references").

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noted by the Examiner, Dorsey *already* purports in para. 38 to provide scalable translation, hence no rational basis that has been shown to modify Dorsey to include the teachings of the admitted prior art.

Assuming one having ordinary skill in the art would have been motivated to combine the teachings of Dorsey and the admitted prior art, the hypothetical combination would disclose no more than the system of Figure 1 of Applicant's specification, where the BSTUN resources 18a and 18b of the respective routers 16a and 16b include the packet translator of Dorsey et al. in order to perform layer 2 packet translation between the bisync links 17 and the TCP/IP or Frame Relay links connecting the routers 16a and 16b. Note, however, that Dorsey would only be applied to the layer 2 packet translation (i.e., the layer 2 bisync link 17 and the layer 2 link used by the router 16a to connect to the next node in the network 20), and not the layer 3 (e.g., IP) or layer 4 (e.g., TCP) protocols; rather, the admitted prior art already describes that the entire bisync frame is **encapsulated** for transmission between the tail-end router 16a and the headend router 16b.

Further, the hypothetical combination still would neither disclose nor suggest the claimed "new header" that specifies *attributes of the Base-24 protocol data **and the automated banking device**", especially since any new IP header generated by the router 16a/16b would specify the source address of the router 16a/16b, and not an address of the automated banking device.

For these and other reasons, the §103 rejection of claims 1, 11, 21, and 31 should be withdrawn.

Applicant further traverses the rejections of claim 11 as legally inadequate: the rejection of claim 11 is distinct from claim 1, and as such fails to identify where the prior art discloses or suggests the claimed bisync to IP resource, the claimed IP interface, or the claimed serial interface. It is well settled that each and every claim limitation must be considered. As specified in MPEP §2143.03, entitled "**All Claim Limitations Must Be Taught or Suggested**": "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior

art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." MPEP §2143.03 at 2100-139 (Rev. 3, Aug. 2005).

The rejection of claim 11 also is legally deficient because there is no showing of any motivation or suggestion to combine the teachings. However, a prima facie case of obviousness under §103 requires a showing of a motivation or suggestion to combine the teachings in the manner claimed. See generally, MPEP §2143 and §2143.01. The Examiner is respectfully reminded that <u>each and every rejection</u> requires a showing of a motivation to combine the teachings in the manner claimed.

Applicant further traverses the rejection of dependent claims 8, 18, 28, and 38, as there is <u>no</u> disclosure or suggestion whatsoever in Dorsey of specifying status/sense information, as claimed. Rather, Dorsey simply provides a generic description of generating a new header by <u>selectively</u> using a selected part of the original frame stored in memory 53a, <u>substitute information</u> from information sources 54 and 55, and/or instruction operands (see, e.g., para. 56 at lines 4-11). However, any and all translation is <u>strictly dependent on the original protocol and the new protocol</u> (see, e.g., para. 42, 63).

Applicant traverses the Examiner's interpretation of the admitted prior art as a suggestion that status information would be placed in the new header: the admitted prior art <u>explicitly specifies</u> that the status information was sent and received <u>locally</u> as described in Figure 1:

> Newer automated teller machines are TCP/IP based and connect to a host server via an IP network 20, enabling the host server to communicate with the automated teller machines via a local area network and wide area network. However, such TCP/IP based ATMs lack management support, as found in legacy ATMs utilizing bisync protocol as illustrated above with respect to Figure 1. In particular, the host server may be unable to determine correction status of a TCP/IP based ATM to determine, for example, whether the ATM utilizing TCP/IP connections needs user intervention.

(Page 3, lines 10-16).

As described on page 2, line 17 et seq., each router 17 (e.g., 16a included a <u>local acknowledgement (LACK) poller state machine</u> 26 for sending poll requests to the local ATM

12. "Hence, in the case of BSC local acknowledgment, *only the data frames are encapsulated* with a BSTUN header and forwarded by the router 16." (Page 2, lines 22-24). In the case where local acknowledgement is <u>not</u> required, data and control frames are *encapsulated* (see page 2, lines 9-16).

Hence, the admitted prior art provides no disclosure or suggestion whatsoever that the *new header* includes the status / sense information, as claimed. Although the test for establishing an implicit motivation in the prior art is what a prior art statement would have suggested to those of ordinary skill, such a statement "must be considered *in the context of the teaching of the entire reference.*" *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

For these and other reasons, the rejection of claims 8, 18, 28, and 38 should be withdrawn.

In view of the above, it is believed this application is in condition for allowance, and such a Notice is respectfully solicited.

To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including any missing or insufficient fees under 37 C.F.R. 1.17(a), to Deposit Account No. 50-1130, under Order No. 95-477, and please credit any excess fees to such deposit account.

Respectfully submitted,

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